



Attorney Docket: 030268-0275922
Client Reference: 9637US/CONT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: VAN
BENTHEM ET AL.
Application No.: 09/754,243

Confirmation Number: 3640

Group Art Unit: 1711

Filed: January 5, 2001

Examiner: S. Berman

Title: POWDER PAINT BINDER COMPOSITION

November 10, 2003

PETITION UNDER 37 C.F.R. 1.182
REQUEST FOR WITHDRAWAL OF TERMINAL DISCLAIMER

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir;

Applicants hereby petition the Commissioner, under 37 C.F.R. 1.182, to withdraw the Terminal Disclaimer filed on July 17, 2002, and noted to have been accepted and recorded in Paper No. 15, mailed December 24, 2002 (see page 2, lines 1-4). Please charge the petition fee required by 37 C.F.R. 1.17(h) to Deposit Account No. 03-3975, referencing Applicant's Docket Number 030268/0275922. A duplicate of this paper is included for this purpose. This petition is authorized and in accordance with MPEP § 1490 page 1400-86 (August 2001, as revised February 2003).

This petition should be granted because the circumstances leading to the filing of the Terminal Disclaimer are no longer present in the application as currently pending, pursuant to an Amendment filed concurrently herewith. Specifically, that portion of the claimed subject matter which prompted an obviousness-type double patenting rejection and the filing of the Terminal Disclaimer has been excised from the claims such that an obviousness-type double patenting rejection would no longer lie or be appropriate.

11/13/2003 AMONDAF1 00000019 033975 09754243

01 FC:1460 130.00 DA

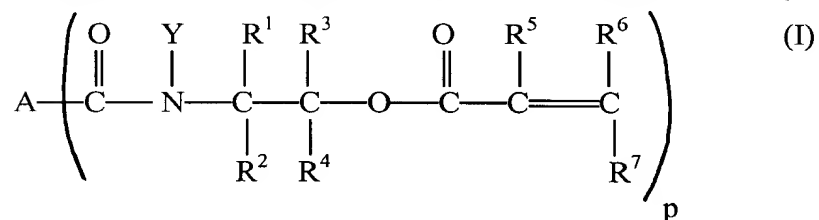
Statement of Facts

1. An obviousness-type double patenting was issued in the Office Action dated April 17, 2002, Paper No. 8. On pages 4-5 of Paper No. 8, then pending claims 1-8 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,245,829. As stated therein,

“Although the conflicting claims are not identical, they are not patentably distinct from each other because formula (I) in the instant claims encompasses species set forth in formula (I) in claim 1 of US ‘829. For example, “n” in the instant formula (I) can be 1 or 2 and Y can be hydrogen, a C₁₋₈ alkyl or a group of formula (II), thus reading on the formula set forth in US ‘829. **‘A’ can be a monovalent or polyvalent organic group as set forth in claim 1 of US ‘829.**” (Emphasis added.)

2. Claim 1 of US ‘829 recites:

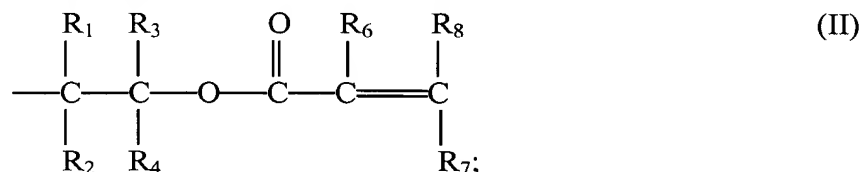
--1. A radiation curable coating composition comprising a compound according to formula (I)



where:

A = a monovalent or polyvalent organic group selected from saturated or unsaturated (C₁-C₆₀) alkyl groups or (C₆-C₁₀) aryl groups,

Y = hydrogen, a (C₁ - C₈) alkyl group or



wherein

R₁, R₂, R₃, R₄ are, identical or different, hydrogen or a linear, branched or cyclic (C₁-C₈) alkyl chain;

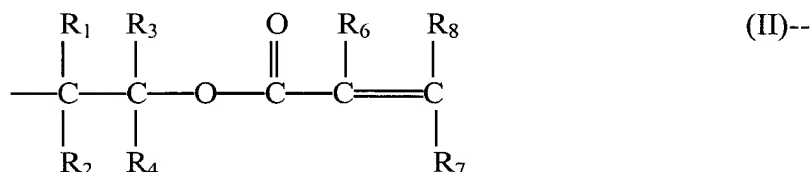
R₅ = hydrogen, (C₁-C₅) alkyl, -CH₂OH or CH₂COOX;

R₆, R, (sic R₇) = hydrogen, (C₁-C₈) alkyl, (C₆-C₁₀) aryl or coox (sic, COOX);

X = hydrogen or (C₁-C₈) alkyl;

P = 1 or 2 with the proviso that when p = 1,

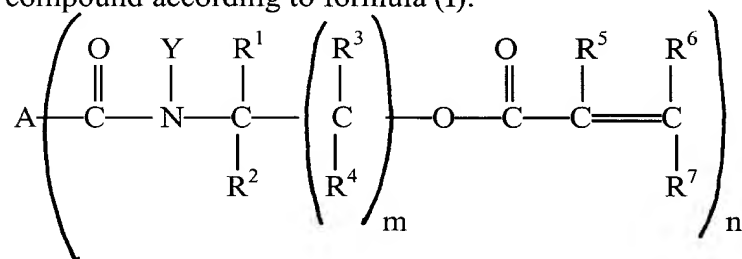
y (sic Y) =



3. Claims 1 and 2 of the present application, at the time of the obviousness-type double patenting rejection recited:

--1. A radiation curable powder paint binder composition containing a radiation curable compound being a mono or multivalent carboxylic ester of a β, γ, δ, or ε-hydroxyalkylamide group containing compound, in which the carboxylic ester is derived from an α,β-ethylenically unsaturated carboxylic acid.--

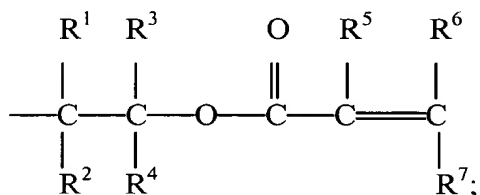
--2. A composition according to Claim 1, characterized in that the compound is a compound according to formula (I):



where:

A = hydrogen, or a monovalent op (sic, or) polyvalent organic group which is derived from a saturated or unsaturated (C₁-C₆₀) alkyl group, derived from an (C₆-C₁₀) aryl group or a polymer P. (sic)

Y = hydrogen, an (C₁-C₈) alkyl group or



R^1, R^2, R^3, R^4 are, identical or different, hydrogen or a linear (sic), branched or cyclic (C_1 - C_8) alkyl chain;

R^5 = hydrogen, (C_1 - C_5) alkyl, $-CH_2OH$ or CH_2COOX ;

R^6, R^7 = hydrogen, (C_1 - C_8) alkyl, (C_6 - C_{10}) aryl or $COOX$;

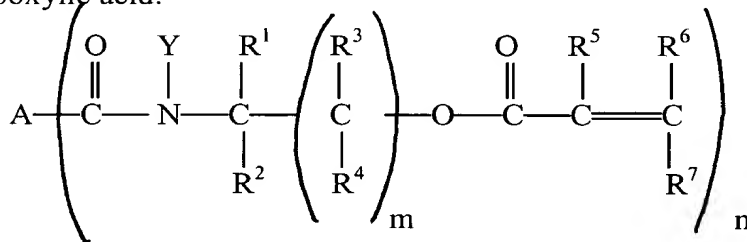
X = hydrogen or (C_1 - C_8) alkyl;

n = 1-1000 and

m = 1-4--

4. After entry of the concurrently filed Supplemental Amendment, the only independent claim, claim 27, reads as follows:

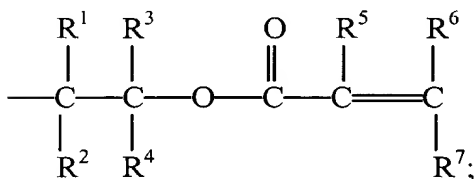
--27. A radiation curable compound represented by the following formula (I) and which is a mono or multi valent carboxylic acid ester of a β, γ, δ or ϵ -hydroxy-alkylamide group containing compound, wherein the ester is derived from an α, β -ethylenically unsaturated carboxylic acid:



where:

A = a condensation polymer P which is a polyester, polylactone, polyamide, polyesteramide, polyesterether, polyurethane, polyurethane-urea, a linear polyether derived from diol, or branched polyether comprising at least one trifunctional alcohol unit;

Y = hydrogen, an alkyl group having from 1 to 8 carbon atoms or



R^1, R^2, R^3, R^4 are, identical or different, hydrogen or a linear, branched or cyclic (C_1 - C_8) alkyl chain;

R^5 = hydrogen, (C_1 - C_5) alkyl, $-CH_2OH$ or CH_2COOX ;

R^6, R^7 = hydrogen, (C_1 - C_8) alkyl, (C_6 - C_{10}) aryl or $COOX$;

X = hydrogen or (C_1 - C_8) alkyl;

n = 1-1000 and

m = 1-4.—

5. In the Office Action, Paper No. 24, mailed June 16, 2003, restriction was required under 35 U.S.C. § 121, as follows:

I. Claims 2, 3 and 9-23, drawn to a radiation curable “compound” of formula (I) that is a non-polymeric compound,

II. Claims 2, 3, 9-23 and 27-32, drawn to or a polymeric compound,

In support of the requirement for restriction, the Action states,

“In the instant case the different inventions would be expected to have different effects since one invention is a radiation curable compound and the second invention is a radiation curable polymer. While the compound and the polymer each contain at least one acrylated alkylamide functional group, the properties of the compounds and the products obtained by curing the compounds would be expected to be materially different from the properties of the polymers and the products obtained by curing the polymers, in the absence of evidence to the contrary.”

6. In the Communication (Amendment) filed June 23, 2003, Applicants elected Group II, “namely, those claims wherein the radiation-curable compound is a polymeric compound.”

7. Applicants were orally informed, in a telephone conversation with the Examiner, on August 27, 2003, that claim 27 (and the claims dependent thereon) would be allowed upon

cancellation of the non-elected claims, including then pending claim 2, encompassing the non-elected subject matter. This was confirmed in the Office Action issued September 8, 2003 in which claims 27-33 were allowed and claims 2, 3, 9-21 and 34 were withdrawn from consideration.

8. In the concurrently filed Amendment, claims 2, 9 and 10 are cancelled and claims 3 and 11-21 are amended to depend from claim 27. None of the currently pending claims encompass the embodiment which was the subject of the obviousness-type double patenting rejection or of the requirement for restriction/election.

Points to be Reviewed

6. The Commissioner is requested to review whether Applicants are entitled to the relief requested herein, namely, withdrawal of the previously filed and recorded Terminal Disclaimer. It is submitted that this review should include consideration of the propriety of the obviousness-type double patenting rejection in view of the changed nature of the claimed subject matter wherein the definition of “A” in claim 27 is a condensation polymer; whereas the definition of “A” in US 6,245,829, over which the Terminal Disclaimer was filed, is a “monovalent or polyvalent organic group selected from saturated or unsaturated (C1-C60) alkyl groups or (C6-C10) aryl groups” and noting that the basis for the obviousness-type double patenting rejection, as stated in Paper No. 8, page 5, was, *inter alia* “ ‘A’ can be a monovalent or polyvalent organic group as set forth in claim 1 of US ‘829.’”).

Action Requested

Applicants request that the Terminal Disclaimer recorded in the subject application be withdrawn and that the application be passed to issue without any disclaimer of the terminal portion of the patent to issue on the subject application.

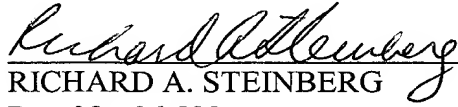
Reasons Why Petition Should be Granted

As explained in the above statement of facts the state of the claims at the time the obviousness-type double patenting rejection issued has been changed such that there is no longer an overlap in the definition of "A" in the presently claimed invention and the claims of US '829. Furthermore, as apparent from the restriction requirement (Fact No. 5) the claims to the radiation-curable compounds were considered to be independent and distinct from the claims for the radiation-curable polymers.

Therefore, the claims of the present application would not have been obvious in view of the claims of US '829. Accordingly, no Terminal Disclaimer is required for the patent to issue from the subject application, and therefore, should be withdrawn.

Accordingly, for the reasons stated herein, granting of this petition is respectfully requested.

Respectfully submitted,
PILLSBURY WINTHROP LLP


RICHARD A. STEINBERG
Reg. No. 26,588
Tel. No. (703) 905-2039
Fax No. (703) 905-2500

PAUL L. SHARER
Reg. No. 36,004
Tel. No. (703) 905-2180

P.O. Box 10500
McLean, VA 22102
(703) 905-2000



George

DA CS

PTO/SB/17 (10-03)

Approved for use through 07/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 130.00

Complete if Known

Application Number	09/754,243
Filing Date	January 5, 2001
First Named Inventor	RUDOLPHUS A T M VAN BENTHEM
Examiner Name	S. Berman
Art Unit	1711
Attorney Docket No.	030268-0275922

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number: 033975
Deposit Account Name: PILLSBURY WINTHROP LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$) 0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		Extra Claims		Fee from below	Fee Paid
Independent	Multiple Dependent				
18		-25** = -7	X		0
		-3** = -1	X		0

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	18	2202	9	Claims in excess of 20	
1201	86	2201	43	Independent claims in excess of 3	
1203	290	2203	145	Multiple dependent claim, if not paid	
1204	86	2204	43	** Reissue independent claims over original patent	
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$) 0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	130.00
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 130.00

SUBMITTED BY

Name (Print/Type)	Richard A. Steinberg	Registration No. (Attorney/Agent)	26588	Telephone	(703) 905-2039
Signature	Richard A. Steinberg	Date	November 10, 2003		

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.